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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/630,262  | 07/30/2003  | Xueying Huang        | CL1942 US NA        | 3962             |
| 24199   | 7590        | 01/05/2007           | EXAMINER            |                  |
| DUPONT PERFORMANCE ELASTOMERS L.L.C.<br>PATENT RECORDS CENTER<br>4417 LANCASTER PIKE, BARLEY MILL PLAZA P25<br>WILMINGTON, DE 19805 |             |                      | MORAN, MARJORIE A   |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             |                      |                     | 1631             |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS  |             | 01/05/2007           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 10/630,262             | HUANG ET AL.        |
| Examiner                     | Art Unit               |                     |
| Marjorie A. Moran            | 1631                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 04 October 2006.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-11 and 13-34 is/are pending in the application.  
4a) Of the above claim(s) 16-34 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-11 and 13-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/3/03; 9/27/04.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-17 and species of: iron oxide, tiopronin, short chain ethylene glycol oligomers, glutathione-S-transferase/glutathione, zinc finger sequence of SEQ ID NO: 1 in the replies filed on 7/5/06 and 10/4/06 is acknowledged.

Claims 16-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species or Invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/5/06.

An action on the merits of claims 1-11 and 13-15, as they read on the elected species, follows.

***Information Disclosure Statement***

The IDS filed 11/3/03 has been considered in full. The IDS filed 11/27/04 has been considered in part.

The information disclosure statement filed 11/27/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but not all the information referred to therein has been considered. A copy of the 1999 reference by MARTIN (Adv. Mater.) has not been filed, as required by 37 CFR 1.98, therefore the citation has not been considered and has been crossed out.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "-X", and the claim also recites (Cl, Br, I) which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WEISS et al. (US 6,207,392), KRESSE et al. (IDS ref: US 6,048,515), EWALT et al. (IDS ref: US 5,922,537), EDWARDS et al. (US 2002/0120405, filed 9/27/2000), TEMPLETON et al. (Langmuir (1999) vol. 15, lines 66-76), and CHOO et al. (WO 2001/53478).

WEISS teaches a semiconductor nanocrystal compound comprising a nanoparticle and a bifunctional linking agent Col. 2, lines 20-47). WEISS teaches that his

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linking agent comprises both a molecule capable of linking to a nanocrystal and a recognition molecule, which may be a protein (col. 9, lines 14-35). WEISS does not specifically teach that his linking agent comprises a member of the pair of glutathione-S-transferase/glutathione nor a zinc-finger binding protein as his recognition molecule. WEISS teaches that his semiconductor nanocrystal may be coated (col. 10, lines 22-26), but does not teach either tiopronen nor ethylene glycol coatings.

KRESSE teaches iron oxide nanoparticles coated with low molecular weight compounds, including polyethylene glycol, which may be used to stabilize the nanoparticle and enhance binding of bifunctional "targeting" compounds (col. 12, lines 17-30, col. 13, lines 14-25, and col. 15, lines 3-14).

EWART teaches nanoparticles comprising iron oxide cores (col. 9, lines 35-47) and a bifunctional linker wherein a recognition molecule may be a "zinc-finger" protein (col. 7, lines 39-67 and col. 8, lines 62-68).

EDWARDS teaches use of GST/glutathione tags for selectively anchoring proteins to a solid support, specifically to a semiconductor measuring device (para 38).

TEMPLETON teaches tiopronin monolayers surrounding metallic nanoparticles, wherein tiopronin stabilizes and protects the core of the monolayer (abstract).

CHOO teaches that a zinc finger protein shown in Example 1 (page 9) binds to a sequence which is 100% identical to instant SEQ ID NO: 1, and teaches that his protein is particularly useful in biotechnology (abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to have coated the nanoparticles of WEISS with the low molecular weight (i.e.

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short chain) ethylene glycol of KRESSE and the tiopronin of TEMPLETON where the motivation would have been to stabilize the nanoparticle and enhance binding of bifunctional linking agents, as taught by both KRESSE and TEMPLETON. One skilled in the art would reasonably have expected success in coating the nanoparticle of WEISS with the ethylene glycol and tiopronin of KRESSE and TEMPLETON because all teach coating metal cores to create nanoparticles. It would also have been obvious to one of ordinary skill in the art at the time of invention to have used the GST tag of EDWARDS as one side of the bifunctional reagent of WEISS where the motivation would have been to use a selective anchor for attaching the bifunctional reagent to the solid nanoparticle semiconductor, as taught by EDWARDS. It also would have been obvious to have used a zinc finger protein, specifically the sequence of CHOO where the motivation would have been to use a protein which is particularly useful in biotechnology, as taught by CHOO, and which is known to be a recognition/affinity molecule for use with nanoparticles, as taught by EWART. It would also have been obvious to have used iron oxide as the core of the nanoparticle of WEISS, TEMPLETON, KRESE, EDWARDS and CHOO where the motivation would have been to provide a specific functionality, as taught by EDWARDS.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571)

272-0720. The examiner can normally be reached on Monday-Friday; 6 am-2:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571)272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marjorie A. Moran  
Primary Examiner  
Art Unit 1631

*Marjorie A. Moran*  
12/24/06